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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,477	09/05/2003	Carey E. Garibay	BEAS-01454US4	8635

23910 7590 04/30/2008

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EXAMINER	
KUCAB, JAMIE R	
ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
04/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/656,477	GARIBAY ET AL.	
	Examiner	Art Unit	
	JAMIE KUCAB	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 3-9, 19, and 21-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicant's response filed March 11, 2008 is acknowledged.

2. Claims 1, 3-9, 19, and 21-35 are pending in the application.

3. This Office action is given Paper No. 20080422 for reference purposes only.

4. Based on a comparison of the PGPub US 2004/0249762 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary, any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 3-9, 19, and 21-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al. (6,189,146) in view of Singh et al. (6,816,842) and further in view of Fenson et al. (2002/0065681).

7. As per claims 1, 3-9, 19, and 21-35, Misra et al. teach a method comprising providing configuration information concerning a software license (column 6, lines 50-64; column/line 7/25-8/33; column 13, lines 12-23) and maintaining a digital record of the license (column 7, lines 12-21; column 8, lines 35-67; column/line 9/29-10/60). Misra

et al. also teach license information such as software environment (e.g. operating system), the number of licenses (e.g. number of CPUs), unique computer identifiers (abstract; column 9, lines 40-50; column 10, lines 50-60; column/line 12/40-13/11) and maintaining a transaction history that changes to the configuration information (column 6, lines 50-64; column 8, lines 35-67; column 16, lines 38-43 and 56-63; column 17, lines 8-25).

8. Misra et al. do not specifically disclose input fields for the input of configuration information. Singh et al. teach a licensing system where a customer requests a license by input license information into fields on a webpage (column 10, lines 12-27).

9. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Misra et al. and Singh et al. in order to provide a customer with an efficient method for entering data related to a license request ('146, column 6, lines 50-64; column 13, lines 12-32).

10. The combination of Misra / Singh fails to explicitly disclose that the fields are defined by a group administrator and wherein at least one of the fields defined by the group administrator are required fields.

11. Fenson et al. teach fields that are defined by a group administrator (administrator, Abstract, [0054]) and wherein at least one of the fields defined by the group administrator are required fields ([0067]).

12. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Misra / Singh to include the group administrator

defined fields and required fields of Fenson et al. with the motivation of achieving low-cost customization of web pages ('681 [0005]).

13. Applicant's claims continue to recite limitations and/or language that suggests or makes optional but does not require steps to be performed. For example, claim 7 recites "can change". Therefore, as language that does not require steps to be performed does not limit the scope of the claimed method (MPEP §2106 II C; *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); *In re Johnston*, 77 USPQ2d 1788 (CAFC 2006)), what Applicant's claimed method may or may not do will not distinguish the claims from the prior art. In addition, Applicant attempts to further describe the method by relying on data stored in computer memory (e.g. configuration information, maintaining transaction history that indicates, the group administration application is a web application that authenticates..., claims 9, 27, 28, and 35). However, as the configuration information is not functionally related to the memory in which it is stored it will not distinguish the claimed method from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994), *Ex parte Masham*, 2 USPQ2d 1647 (1987); MPEP 2106.01 II).

Response to Arguments

14. Applicant's arguments with respect to the 103 rejections of claims 1, 3-9, 19, and 21-35 have been fully considered but they are not persuasive. Applicant argues that Fenson does not "define" the fields. However, as Applicant admits, Fenson does select,

require and label fields. Both selecting and labeling are methods of defining a field within the broadest reasonable interpretation of the word "define".

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim

amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

19. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621